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25 AUG 2003

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In re Application of:  
FUKISHIMA, Naoshi, et al.  
U.S. Application No.: 10/645,085  
Filing Date: 17 October 2002  
Attorney's Docket No.: 065678/0107  
For: AGONIST ANTIBODIES

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DECISION

This decision is issued in response to applicants' "Petition Under 37 CFR 1.182 And Accompanying Request For Continuation-In- Part Application" filed 24 January 2003 in related U.S. national stage application 10/257,864. Applicants have paid the required petition fee.

### **BACKGROUND**

On 17 April 2001, applicants filed international application PCT/JP01/03288 which designated the United States and claimed a priority date of 17 April 2000. On 25 October 2001, a copy of the international application was transmitted by the International Bureau (IB) to the USPTO.

A Demand electing the United States was filed priority to the expiration of nineteen months from the priority date. Accordingly, the deadline for submitting the basic national fee was thirty months from the priority date, i.e., 17 October 2002.

On 17 October 2002, applicants filed materials to initiate a U.S. national stage of international application PCT/JP01/03288. The transmittal letter included with the submission was titled "Transmittal Letter For A PCT International Application Entering The National Stage In The U.S. As A Designated Or Elected Office Under 35 U.S.C. 371." The Transmittal Letter was accompanied by, among other materials, payment of the basic national fee, a translation of the international application into English, and a Preliminary Amendment. Among the amendments contained in the Preliminary Amendment was the deletion of pages 1-51 of the sequence listing, to be replaced with pages 1-57 of a substitute sequence listing attached thereto. The Preliminary Amendment stated that the substitute sheets contained no new matter. This submission was assigned application number 10/257,864.

On 24 December 2002, the DO/EO/US mailed a Notification Of Missing Requirements indicating that an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the declaration later than thirty months after the priority date, additional claims fees and sequence materials were required.

The petition herein included the required petition fee. It was filed with a copy of the complete disclosure required to complete the application, that is, the specification, claims, drawings, and preliminary amendment which contain the disclosure from the international application and the added subject matter. And it was accompanied by a transmittal letter for the continuation-in-part application which noted that the required filing fee for the continuation-in-part application will be submitted in response to the Notice To File Missing Parts Of The Application. These materials provide all the requirements for a grantable petition.

The materials submitted with the petition will be treated as a continuation-in-part application, assigned U.S. Application number 10/645,085. Application Number 10/257,864 will continue to be processed as a national stage under 35 U.S.C. 371 (it is noted that such case will become abandoned based on the failure to file materials responsive to the Notification Of Missing Requirements mailed 24 December 2002.

Any period of adjustment to the term of a patent under 35 U.S.C. 154(b)(May 29 2000) in either application number 10/257,864 or 10/645,085 may be reduced by the period of time beginning on the filing date accorded under 35 U.S.C. 111 and ending on the mailing date of this decision.

### CONCLUSION

Applicants' petition under 37 CFR 1.182 is **GRANTED**.

The papers attached to the petition, originally filed on 17 October 2002, will be treated as a separate U.S. application filed under 35 U.S.C. 111(a) as a continuation-in-part of international application PCT/JP01/03288. This application will be assigned application number 10/645,085 and will be assigned a filing date of 17 October 2002.

The papers relating to application number 10/645,085 are being forwarded to the Office Of Initial Patent Examination for further processing in accord with this decision.



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On 24 January 2003, applicants filed materials including the "Petition Under 37 CFR 1.182 And Accompanying Request For Continuation-In- Part Application" considered herein, a Second Preliminary Amendment, sequence materials, and a "Continuing Patent Application Transmittal Letter. The petition and accompanying materials note that the materials filed 17 October 2002 mistakenly contained additional matter to that disclosed in the international application; the petition therefore seeks to create a continuation-in-part application which includes the additional matter contained in the 17 October 2002 submission and which has a filing date of 17 October 2002 with respect to this added subject matter.

### **DISCUSSION**

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.494(f):

The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states that:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

As noted above, applicants' original Transmittal Letter, filed 17 October 2002, specifically identified the accompanying submission as a submission to enter the national stage under 35 U.S.C. 371. No contradictory instructions were submitted. Accordingly, application 10/257,864 was appropriately created as a national stage application under 35 U.S.C. 371.

However, despite the statement in the Preliminary Amendment filed 17 October 2002 that no new matter was included in the amendment, the present petition states that the 17 October 2002 submission did include "the disclosure from international application PCT/JP01/03288 as well as additional matter." Specifically, the petition states that "[t]he additional matter is SEQ ID NOS. 73-84, which appear on pages 51-57 of the Sequence Listing filed with the application filing papers filed on October 17, 2002." Subject matter beyond that disclosed in the international application cannot be entered in a national stage filing under 35 U.S.C. 371. Thus, in order for the additional subject matter included with the 17 October 2002 submission to be granted a 17 October 2002 filing date, applicants must submit a grantable petition seeking to have the disclosure of 17 October 2002 treated as a continuation-in-part application under 35 U.S.C. 111(a).